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HAROLD B. WILLEY, Clerk

IN THE

Supreme Court of the United States

OCTOBER TERM, 1955.

No. 674

ROSE ALEXANDER,

Petitioner,

v.

IRVING TRUST COMPANY as Executor under the Last Will and Testament of Clarence P. Oberndorf, Deceased, and COLUMBIA UNIVERSITY PRESS,

Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT.

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The petitioner, on behalf of Rose Alexander, prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Second Circuit entered in the above-entitled case on December 20, 1955.

Opinions Below.

The opinion of the District Court for the Southern District of New York is reported at 132 F. Supp. 364. The opinion of the Court of Appeals for the Second Circuit (R. 99-100) is not yet reported but is *"Per Curiam"* and adopts the opinion of the lower court in all respects (R. 99-100).

An application for rehearing was denied on January 9, 1956 (R. 110) by order bearing that date.

Jurisdiction.

The judgment of the Court of Appeals for the Second Circuit was entered on December 20, 1955 (R. 101). The jurisdiction of this Court is invoked under 28 U. S. C. 1254 (1).

Question Presented.

In 1939 the petitioner authored an original article, then published, entitled *"Oliver Wendell Holmes—Psychiatrist"* which, by its text, disclosed for the first time the fact that *over 50 years before* a novel written by Dr. Holmes, entitled "Elsie Venner" revealed the fact that he, as a physician, had complete knowledge of every symptom of the disease known as *dementia praecox* (R. 25, 19) and that he was pioneering in a field, theretofore untouched in literature or science, with his careful and exact experimentation (R. 25, 19).

This work of petitioner further set forth that the novel showed that Dr. Holmes' prognosis, diagnosis and treatment were exactly the same as they are at the present time in the management of *dementia praecox* (R. 26, 22, 53-54).

No one had theretofore discovered and announced this unique fact (R. 57).

The petitioner and the deceased defendant, Clarence P. Oberndorf, were both physicians specializing in psychiatric practice, the former in California, the latter in New York (R. 61). Both frequently authored articles dealing with medical subjects, especially psychiatry.

In this field the professional value of ascertaining by diligent research a fact such as plaintiff revealed as to Dr. Holmes hitherto unsuspected knowledge of the disease known as *dementia praecox* and his modern type treatment

thereof was an immense and a crowning achievement to plaintiff's many years of research (R. 57-58; 59).

In *1943* the defendants published the *first edition* of a book entitled "The Psychiatric Novels of Oliver Wendell Holmes" Abridgment, Introduction and Annotation by Clarence P. Oberndorf, M. D. The courts below held that no access to plaintiff's work was established; at least so far as this edition went.

Here the question presented relates to *a second edition* of defendant's work published *in 1946* and entitled "The Psychiatric Novels of Oliver Wendell Holmes" Abridgment, Introduction and Psychiatric Annotations by Clarence P. Oberndorf, M. D.

It is not disputed that subsequent to 1943 and prior to 1946 the defendants had a *plenitude of access* to the article of defendant having complete copies furnished to them with letters of protest from the plaintiff.

This *second edition* was advertised by defendants as "calling the attention of psychiatrists and the lay public to the *hitherto unnoticed* psychological understanding of one of our famous doctors" and as demonstrating "Holmes' *hitherto unsuspected* knowledge of neuroses and the more clinical mental diseases" (R. 80-81, Exhibit 10). (Italics ours.)

The plaintiff asked an injunction and contended that she had a right to the protection of the fruit of her years of labor, *this notable discovery,* which astounded the professors of Harvard and Yale Universities, but that the defendant's acts in connection with this 1946 second edition and their advertising that plaintiff's revelation was Oberndorf's discovery, *independently of any claim to copyright protection,* constituted unfair competition and destroyed her equitable rights therein which she valued at $75,000 (R. 73, 59).

The question presented to the discretion of this court in asking a review on writ of certiorari is based on special and important reasons which will be hereinafter set forth.

The rights of this petitioner to an injunction are protected under the ruling of this Court in *International News Service* v. *Associated Press,* 248 U. S. 215 which has never been reversed but which the lower appeal courts, especially in the Second Circuit, have consistently maintained to be *sui generis* and have held it applicable only if the same facts exist.

It is a matter of public importance to have a restatement by this Court as to whether the masterly reasoning as to equitable property and rights expounded in that opinion still prevails or as to whether the doctrine of irremediable damage must be submitted to, as contended in the opinions of the Circuit Court of Appeals cited by the District Court herein.

Statement.

The facts material to the questions presented are undisputed, in relation to the circumstances under which the 1946 or second edition of defendant's book was issued.

Especially must it be conceded that he had theretofore read the article written by the plaintiff as he expressly refers to her and to an observation made by her therein in the body of his work (R. 28).

The plaintiff never met or spoke to defendant so the use of this matter was clearly copied from her writing (p. 49).

The appendix submitted herewith contains a complete and verbatim comparison of the two writings involved in parallel columns so far as the plaintiff claims identity between them (R. 24-35).

It is respectfully submitted despite the rulings below in this case that plaintiff's article is shown by that comparison to have been substantially followed in all material aspects by defendant's introduction.

Defendant's work except for the part following and using plaintiff's discovery is for the most part an abridgment, a verbatim copy of parts of the three "medicated" novels of Dr. Holmes.

Copying these sections did not constitute the discovery of Dr. Holmes' knowledge of neuroses advertised and claimed as its feature in the 2nd edition published in 1946.

The record (84) contains a letter dated *December 13 1943* (Plaintiff's Exhibit 13) written by Dr. Oberndorf to plaintiff on receipt of her letter enclosing a reprint of her article in which he acknowledges receipt of such copy so that since 1943 he had her article in his possession. She sent him the reprint with a protest after she saw his first edition (R. 84).

The record also contains another letter dated Feb. 2, 1944 to the Columbia University Press transmitting a similar copy and protesting against the infringement shown in the defendant's first or 1943 edition. (R. 85, Plaintiff's Ex. 14).

On June 5, 1944 after receiving a copy of plaintiff's article Mr. Proffitt of the Columbia University Press wrote to her and said: "The reprint which you sent us did not contain any information which would indicate that Dr. Oberndorf made use of your material * * *" (R., p. 63).

In any event in 1946 when the defendants published their 2nd edition announcing Dr. Oberndorf's revelation of Dr. Holmes' knowledge of neuroses *"hitherto unsuspected"* it is obvious that both author and publisher had complete knowledge to the contrary both having before them copies of the article written by plaintiff in 1939, seven

years prior thereto. Each had had such copy for over three years when their false claim was asserted that Holmes' knowledge was "hitherto unnoticed".

Their knowledge that their statements in this regard were atrociously false is conclusively established.

Dr. Oberndorf tries to get around this by saying in effect—I did not misrepresent as to plaintiff's discovery because a man named Van Wyck Brooks discovered the fact before she did by saying in his book entitled "*Flowering of New England*" in reference to Dr. Holmes on page 494:

> "There were happy streaks in all his writings, and striking applications of modern science; and his essay on 'Mechanism in Thought and Morals' and 'Underground Workshop of Thought,' 'The Unconscious'—was a brilliant anticipation of Dr. Freud. In fact, although 'Elsie Venner', of all these later books was the only one that seriously counted, the doctor knew so much about human nature and had such a tang of his own that one could read him at his worst with pleasure" (R. 60).

And on page 498 the author of this book says:

> "Dr. Holmes, perhaps unwittingly, had played into the hands of Dr. Darwin. He had played into the hands of Dr. Freud. He had played into the hands of another doctor of whom he had never heard, Dr. Marx. One never knows how far a doctor's table talk may carry" (R. 60).

No copy of this book of Van Wyck Brooks was ever offered in evidence and other than as above stated its contents do not appear in the record.

No copies of the essays "Mechanism in Thought and Morals", the "Underground Workshop of Thought" or "The Unconscious" which are described as a brilliant

anticipation of Dr. Freud were ever offered in evidence. Except as stated above, their contents were never divulged so that it could be determined whether they justified the claim that Brooks and not the plaintiff discovered the hitherto unsuspected knowledge of Holmes as to "every symptom of the disease known as dementia praecox" and that Dr. Holmes *"was pioneering in a field hitherto untouched in literature or science"* to use the plaintiff's words (R., p. 25). (Italics ours.)

In his deposition before trial which was interrupted by Dr. Oberndorf's sudden departure and never concluded, he makes the following statement:

> "The source of my orientation and inspiration came from Van Wyck Brooks, whose book was published in 1937, and I acknowledge my indebtedness to Van Wyck Brooks in the book. This was before Dr. Alexander's article appeared in the Medical Record. As a matter of fact, I should be very much interested to know what the source of Dr. Alexander's find was, because she does not refer to 'Mechanism in Thought and Morals' which is the essence of Holmes' contribution" (R. 69).

Dr. Oberndorf was then referred, as quoted below, to the statements about his *discovery*, of Holmes "unsuspected" knowledge printed by defendants on the cover of the second edition in 1946 (R. 72).

> "Q. Would you take a look at these notes on the back cover and tell me whether you agree with the statements made in those reviews? (R. 80, Exhibit 10). A. You embarrass me, because they are all flattery. Which one would you say in particular?"
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> • • • • • •
>
> "Q. In the first one there (referring to Plaintiff's Exhibit 10; R. 81), from Helen Haines of the Pasadena Star News, it says,

'Dr. Oberndorf has made a novel contribution to literature of psychiatry and opened a fascinating byway in a familiar field.' I was wondering if you agreed with the statement that it was a novel contribution? A. In which sense do you mean the word 'novel'?

Q. That there had been no previous articles like it. A. No previous books like it?

Q. No previous books like it. A. I agree to that. I also agree to the last statement, that he has 'opened a fascinating byway in a familiar field * * *' (R. 72).

Q. Where it is said it is a novel contribution, you mean it is novel so far as the format goes? A. I would say 'novel', meaning something new, original.

Q. Perhaps I should call your attention to the reference to an article by Suzanna Haig in the Psychoanalytic Quarterly. It is the fourth paragraph down on the cover. It says, 'Dr. Oberndorf is to be congratulated on calling the attention of psychiatrists and the lay public to the hitherto unnoticed psychological understanding of one of our famous doctors'.

I understand, by reading that, that it meant that no one had noticed the psychological understanding of Holmes before this article.

Q. Is that what it means? A. She didn't know about Van Wyck Brooks. The appearance of this book led to complimentary letters from people like Professor Cobb of Harvard, Professor of Psychiatry there, who said, 'How dull we were not to have noticed it in Boston'. Also from Professor Stanley Williams, professor of literature at Yale, who said, 'It is extraordinary that we didn't notice that.'

Q. That he never noticed the psychiatry of Dr. Holmes? A. Yes. But Van Wyck Brooks did before Alexander.

Q. Then the last statement on that page of the cover, 'Demonstrates Holmes' hitherto unsuspected knowledge of neurosis and more clinical mental

illnesses? (R. 73) A. I am not responsible for those statements.

Q. Dr. Alexander's article did clearly state that Dr. Holmes had knowledge of psychiatry and used psychiatry? A. Van Wyck Brooks said it. She doesn't give Van Wyck Brooks credit, Mr. Mackey. She doesn't give anybody credit.

• • • • • •

Q. On the first page of this article by Dr. Alexander she states, 'The Professor's Story', in the December, 1859 issue, later to be known as 'Elsie Venner', *fully describes every symptom of the disease known as dementia praecox.'* Did you notice that on the first page of her article? A. Yes.

Mr. Asch: You mean has he noticed it since she sent it to him?

Mr. Mackey: Yes.

A. When I read it, I noticed that sentence, yes.

Q. That is *contrary* to the last paragraph on the back cover, is it not?

The Witness: I am not responsible for what the *critics* say" (R. 74). (Italics ours.)

The above is quoted to demonstrate the sense of guilt revealed in Dr. Oberndorf's testimony. His obvious attempts to hide his guilt behind Van Wyck Brooks. His opening attitude toward the *false* statements on the cover, of which he and the publishers were fully aware, namely that "they are all flattery", his rejoicing at his deception of the eminent professors at Harvard and Yale and his final collapse on realization of his exposure when he disclaimed responsibility "for what the critics say".

It is important to note that he expressly admits noticing from reading plaintiff's article that she states that in Elsie Venner Dr. Holmes fully describes every symptom of the disease known as dementia praecox (R. 74).

And yet when he mentions her work in this second edition of 1946 all he credits her with is calling "his attention to an article in which she notes that in the Venner family, insanity appears in one member, Elsie, and criminality in another, her cousin Richard" (R. 28)—Book, page 263.

The basis for invoking the equitable jurisdiction of the Court of first instance was diversity of citizenship and claim of plagiarism under the copyright law as well as unfair competition.

Reasons for Granting Writ.

An important reason for this Court to grant the writ requested is the fact that the Court of Appeals for the Second Circuit, particularly in opinions written by Judge Learned Hand has repeatedly held that the doctrine of *International News Service* v. *Associated Press,* 248 U. S. 215 is not as broad as the learned language of the opinion of Justice Pitney states, but must be limited to the exact fact situation there involved.

This is the interpretation frequently expressed by the lower court in cases cited by Judge Bicks herein (R. 9) and in other cases not cited by him.

Since this Court has not reversed that case and since its language is plain it is fair to assume the Court of Appeals for the Second Circuit is in error and that there is no reason to discard the equitable principles which are the basis of the doctrine enunciated by Justice Pitney.

For example in a footnote to the decision of *Hartford Charga-Plate Association* v. *Youth Centre-Cinderella Stores, Inc.,* 215 F. 2nd 668 decided by the United States Court of Appeals for the Second Circuit on September 17, 1954 (opinion by Clarke, J.) it is said (p. 672):

> "See Judge L. Hand's discussion of the *International News* case in *R. C. A. Mfg. Co.* v. *Whiteman, supra,* 2 Cir., 114 F. 2d 86, 90: 'That much discussed decision really held no more than that a Western newspaper might not take advantage of the fact that it was published some hours later than papers in the East, to copy the news which the plaintiff had collected at its own expense.' In spite of some general language it must be confined to that situation (*Cheney Bros.* v. *Doris Silk Corp.,* 2 Cir., 35 F. 2d 279, 281); certainly it cannot be used as a cover to prevent competitors from ever appropriating the results of the industry, skill and expense of others. 'Property' is a historical concept; one may bestow much labor and ingenuity which inures only to the public benefit; 'ideas', for instance, though upon them all civilization is built, may never be 'owned'. The law does not protect them at all but only their expression; and how far that protection shall go is a question of more or less; an author has no 'natural right' even so far, and is not free to make his own terms with the public. * * *"

This interpretation differs from that of this Court but it seems to have been the basis of the decision below so far as it related to the misappropriation of plaintiff's work and defendants' unfair competition (R. 8-10).

The decision of Bicks, J., does not correctly state plaintiff's claim and it is requested that the parallel column comparison (R. 24-36) and the testimony be examined to discover that plaintiff never rested her claim as there stated on the identity of titles, or ideas, the quotations on the jacket but basically upon the dishonest appropriation of her work and discovery by Oberndorf.

As Justice Holmes of this Court said

> "it substitutes misappropriation in the place of misrepresentation and sells complainant's goods as its own."

International News Service v. *The Associated Press,* 248 U. S. 215, 241-242.

In that same case in the Court below 245 Fed. 244 (C. C. A. 2 C) Judge Hough, wrote:

> "presentation by such appeal of a clear-cut question of law, upon undisputed facts, largely admitted in the pleadings" (p. 247). "These facts enable us to render opinion without danger of even seeming to touch upon discretionary matters" (p. 247).
>
> (b) "unfair competition, like all legal phrases has acquired rather a narrow use. In *McLean* v. *Fleming* 96 U. S. 251 which is now the foundation of American Case Law on this subject, it was said that what equity enjoins the wrongdoer from depriving another of is 'the advantage of celebrity' (p. 251).
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> "Equity, however, is not stayed because a name does not fit, or one is not at hand to accurately describe a wrong of a kind necessarily infrequent. If defendant takes what someone else owns, and sells it as of right, in rivalry with the owner, such competition is more than unfair; it is patently unlawful and the wider comprises the narrower. But, laying aside the right of property as the ultimate foundation of suit, the business method of selling in competition with plaintiff and its members, something falsely represented as gathered by defendant otherwise than from bulletins and early editions is unfair, because it is parasitic and untrue. It is immoral, and that is usually unfair to some one" (p. 252).

Copyright has nothing to do with plaintiff's rights under this theory. **The claim is not as to her rights against the public but peculiarly as to her rights against the defendants.**

Justice Pitney said in the same case when determined in this Court:

> "Obviously, the question of what is unfair competition in business must be determined with particular reference to the character and circumstances of the business. *The question here is not so much the rights of either party as against the public but their rights as between themselves.* See *Morison* v. *Moat,* 9 Hare, 241, 258. And although we may and do assume that neither party has any remaining property interest as against the public in uncopyrighted news matter after the moment of its first publication, it by no means follows that there is no remaining property interest as between themselves. For, to both of them alike, news matter, however little susceptible of ownership or dominion in the absolute sense, is *stock in trade,* to be gathered at the cost of enterprise, organization, skill, labor and money, and to be distributed and sold to those who will pay money for it, as for any other merchandise. Regarding the news, therefore, as *but the material* out of which both parties are seeking to make profits at the same time and in the same field, we hardly can fail to recognize that for this purpose, and as *between them,* it must be regarded as *quasi* property, irrespective of the rights of either as against the public." (Italics ours.)
>
> "In order to sustain the jurisdiction of equity over the controversy, we need not affirm any general and absolute property in the news as such. The rule that a court of equity concerns itself only in the protection of property rights treats any civil right of a pecuniary nature as a property right (In re Sawyer, 124 U. S. 200, 210; In re Wells, 158 U. S. 564, 593); and the right to acquire property by honest

labor or the conduct of a lawful business is as much entitled to protection as the right to guard property already acquired. *Truax* v. *Raich,* 239 U. S. 33, 37-38; *Brennan* v. *United Hatters,* 73 N. J. L. 729, 742; *Barr* v. *Essex Trades Council,* 53 N. J. Eq. 101. It is the right that furnishes the basis of the jurisdiction in the ordinary case of unfair competition" (p. 237).

"The fault in the reasoning lies in applying as a test the right of the complainant as against the public, instead of considering the rights of complainant and defendant, competitors in business, as between themselves. The right of the purchaser of a single newspaper to spread knowledge of its contents gratuitously, for any legitimate purpose not unreasonably interfering with complainant's right to make merchandise of it may be admitted; but to transmit that news for commercial use, in competition with complainant—which is what the defendant has done and seeks to justify—is a very different matter. In doing this defendant, by its very act, admits that it is taking material that has been acquired by the complainant as a result of organization and the expenditure of labor, skill, and money, and which is salable by complainant for money, and that defendant in appropriating it and selling it as its own is endeavoring to reap where it has not sown; and by disposing of it to newspapers that are competitors of plaintiff's members is *appropriating* to itself the harvest of those who have sown. *Stripped of all disguises,* the process amounts to unauthorized interference with the normal operation of complainant's legitimate business precisely at the point where the profit is to be reaped, in order to divert a material portion of the profit from those who have earned it to those who have not; with special advantage to defendant in the competition because of the fact that it is *not burdened with* any part of the expense of gathering the news. The transaction speaks for itself, and a court of equity *ought not to hesitate long*

in characterizing it as unfair competition in business." (Italics ours.)

"The underlying principle is much the same as that which lies at the base of the equitable theory of consideration in the law of trusts—that he who has fairly paid the price should have the beneficial use of the property. *Pom. Eq. Jur.*, § 981. It is no answer to say that complainant spends its money for that which is too fugitive or evanescent to be the subject of property."

"*That might,* and for the purposes of discussion we are assuming that it would, *furnish the* answer in a *common-law controversy. But in a court of equity,* where the question is one of unfair competition, if that which complainant has acquired fairly at substantial cost may be sold fairly at substantial profit, a competitor who is misappropriating it for the purpose of disposing of it to his own profit and to the disadvantage of complainant cannot be heard to say that it is too fugitive or evanescent to be regarded as property. It has all the attributes of property necessary for determining that a misappropriation of it by a competitor is unfair competition because contrary to good conscience" (P. 240). (Italics ours.)

* * * * * *

"It is said that the elements of unfair competition are lacking because there is no attempt by defendant to palm off its goods as those of the complainant, characteristic of the most familiar, if not the most typical, cases of unfair competition. *Howe Scale Co.* v. *Wyckoff, Seamans & Benedict,* 198 U. S. 118, 140. *But we cannot concede that the right to equitable relief is confined to that class of cases.* In the present case the fraud upon complainant's rights is more direct and obvious. Regarding news matter as the mere material from which these two competing parties are endeavoring to make money, and treating

it therefore, as *quasi property* for the purposes of their business because they are both selling it as such, defendant's conduct differs from the ordinary case of unfair competition in trade principally in this that, instead of selling its own goods as those of complainant, it *substituted misappropriation* in the place of misrepresentation, and sells complainant's goods as its own."

"Besides the misappropriation, there are elements of limitation, of false pretense, in defendant's practices. The device of re-writing complainant's news articles, frequently resorted to, carries its own comment. The habitual failure to give credit to complainant for that which is taken is significant. Indeed, the entire system of appropriating complainant's news and transmitting it as a commercial product to defendant's clients and patrons amounts to *a false representation* to them and to their newspaper readers that the news transmitted is the result of defendant's own investigation in the field. But these elements, although accentuating the wrong are not the essence of it. It is *something more than the advantage of celebrity* of which complainant is being deprived" (pp. 239-242). (Italics ours.)

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What defendant Oberndorf, a competitor in psychiatric practice and literature, seized and used at the expense of the plaintiff's lifetime work in the literature of her profession was her discovery—an accomplished fact and not an idea—the result of *her* labor and expense, which astounded Professor Cobb of Harvard and Professor Williams of Yale to such an extent that they wrote in amazement to Dr. Oberndorf when deceived by his larceny thereof from plaintiff (R. 73).

Despite Judge Hand's expressions petitioner feels she should be entitled to an injunction against defendants under the doctrine of the case above cited and quoted.

It is contended that the decisions below erroneously interpret this case.

Conclusion.

For the reasons set forth above, it is respectfully submitted that this petition for a writ of certiorari should be granted.

RICHARD J. MACKEY,
Attorney for and of Counsel
with Petitioner.

February 8, 1956.

Opinion of the United States District Court for the Southern District of New York.

( )*

UNITED STATES DISTRICT COURT,

SOUTHERN DISTRICT OF NEW YORK.

ROSE ALEXANDER,
Plaintiff,
against

IRVING TRUST COMPANY, as Executor under the Last Will and Testament of CLARENCE B. OPERNDORF, Deceased and COLUMBIA UNIVERSITY PRESS,
Defendants.

Civ. 74-349.

Appearances:

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Opinion

BICKS, D. J.

This action for copyright infringement and unfair competition was instituted in 1952, against Clarence P. Oberndorf, as author, and Columbia University Press, as pub-

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* Refers to original pages in Transcript of Record.

lisher of a book entitled "The Psychiatric Novels of Oliver Wendell Holmes", first published in 1943 and revised in 1946. The individual defendant died during the pendency of the action and his executor, the Irving Trust Company, was substituted as a defendant.

The plaintiff claims that defendants' work infringes upon, and unfairly competes with her two-page article entitled "Oliver Wendell Holmes—Psychiatrist" published in a 1939 issue of a now-defunct medical journal. An injunction, damages and an accounting are sought. The owner of the copyright in plaintiff's work, the publisher of the journal in which it appeared, refused plaintiff's demand to execute an assignment of the copyright to her and is not a party to this action. Plaintiff urges that she is the equitable owner of the copyright and that the action was properly brought in her name alone. Jurisdiction of this court rests upon the Copyright Act, Title 17, U. S. C., and on diversity of citizenship.

In comparing plaintiff's and defendants' work to determine whether the later work plagiarized the earlier one, it is to be noted that both proceed from the same premise—the idea or theory that Holmes' novels showed an understanding of psychiatry that was a half century ahead of his time. In the compass of her two pages, plaintiff merely sets forth this theory and adds a few historical facts from both Holmes' life and the history of medicine. The references to the novels themselves are in general terms. The novels are neither summarized nor completely analyzed to establish the basis for plaintiff's conclusions.

Oberndorf, on the other hand, made a painstaking analysis of all three of Holmes' novels showing their practical application in terms of present-day psychiatric knowledge. To the extent that his volume contained a certain amount of historical data, there was necessarily some similarity to plaintiff's article in the facts presented—the manner of expressing them, however, is different. Oberndorf's work was entirely original in its presentation of each of Holmes' three novels, abridged with a view to highlighting their sig-

nificance as psychiatric and analytic studies of neuroses. Holmes' own language is used almost entirely, footnotes being added by the author based largely on his own clinical experience as well as outside sources—treatises and periodical literature on psychiatric and related subjects.

In a nineteen- page introduction to his 270 page volume, Oberndorf traces Holmes' background, attitudes and accomplishments as both author and doctor, then shows parallelisms between Holmes and Freud, whose doctrines Holmes anticipated in these novels. There are quotations from Holmes on such subjects as: the importance of the unconscious as a factor in negativing the concept of absolute freedom of the will; the mechanism of the free association of ideas—a postulate of psychoanalysis; dream life and psychic dualism. Under the heading, "Holmes as a Clinical Psychiatrist", which was Oberndorf's own field, the latter suggests that Holmes' views were so far in advance of the accepted medical theories of his day, that he chose to present his findings to the lay public in the form of these so-called "medicated novels," (a term used in Holmes' own day to describe his novels) the doctors in these works of fiction being a composite picture of Holmes himself. Observing the importance of the many ancestral influences on human behavior, he quotes Holmes' observation that the body "is not a private carriage, but an omnibus," a concept which became the "collective unconscious" of the famed Swiss psychiatrist, Carl Jung. Oberndorf tells the reader that Holmes' attitudes may have been a "compulsion to write off his father's Calvinism and predestination," but that the author prefers to avoid this subjective approach.

After this introduction each of the three stories is told in Holmes' words, with brief summaries where necessary to carry forward the thought. Each story is prefaced by an analysis from a purely psychiatric viewpoint, with footnotes relating the characters to Holmes' own life or to psychiatric observations. Comments at the end of each abridgement again emphasize certain aspects of the novel

in relation to present-day knowledge of the mainsprings of human behavior.

Plaintiff urges that her charge of plagiarism should be sustained because in a minutial dissection of the two works she finds the following similarities: the observation that Elsie Venner suffers from *dementia praecox*, the symptoms including among other things "negativism" and "isolation"; the reference to heredity as a factor responsible for abnormal conduct (in this both refer to Holmes' statement concerning the body as an "omnibus"); the assertion that Holmes anticipated Freud; mention of Holmes' Calvinist parents and his distinguished son, the Supreme Court Justice; comparison of Holmes' reference to the effect of shock as an antidote to mental illness with the use of metrazol in modern shock treatment; enumeration of Holmes' specific medical achievements; listing of certain Holmes' contemporaries—the similarity being in some, and not all of the names mentioned in the two works; a reference to "merry widows", though in entirely different contexts.

Plaintiff urges that access should be inferred from these similarities. Some similarities in two works dealing with the same subject are inevitable. Those complained of here are unavoidable in any work treating with Holmes as a psychiatrist. They would not support a finding of infringement even if access had been established. Yankwich, *Originality in the Law of Intellectual Property*, 11 F. R. D. 457, 462. As indicated by Birrell, in *Seven Lectures on the Law and History of Literary Property*, 167: "The literary larcenist must do more than filch ideas . . . repeat information, borrow phrases, utilize quotation; you must be able to attribute to him the felonious intention of appropriating without independent labor a material part of a protected work." Here there is lacking both proof of access and of substantial similarity.

Plaintiff seeks to attribute access to Oberndorf through a devious chain of acquaintances which Oberndorf and plaintiff had in common. This Court will not engage in speculation or conjecture to make a finding of access.

Allen v. *Walt Disney Productions, D. C.*, 41 F. Supp. 134, 136 (S. D. N. Y. 1941). The burden of proving access rests on plaintiff. *Sarkadi* v. *Wimam*, 135 F. 2d 1002 (2 Cir. 1943); *Jewel Music Pub. Co.* v. *Leo Feist, Inc.*, 62 F. Supp. 596 (S. D. N. Y. 1945). I find that no such access has been established.

A comparison of the two works demonstrates that defendant's work was created through independent labor and without appropriation of any of the literary matter protected by the copyright in plaintiff's work. Assuming that both works present the same idea, it is expressed in defendant's work in a manner totally different from that of plaintiff. A copyright does not pre-empt the field as against others who choose a different means of expressing the same idea. In this respect, it differs from a patent which protects the inventor against any unauthorized use of the discovery itself. As Judge Hough wrote in *Dymow* v. *Bolton*, 11 F. 2d 690 (2d Cir. 1926): "Just as a patent affords protection only to the means of reducing an inventive idea to practice, so the copyright law protects the means of expressly an idea; and it is as near the whole truth as generalization can usually reach that if the same idea can be expressed in a plurality of different manners, a plurality of copyrights may result, and no infringement will exist." A century and a half earlier, Lord Mansfield put the same thought in these words: "we must take care to guard against two extremes equally prejudicial; the one that men of ability, who have employed their time for the service of the community, may not be deprived of their just merits, and the reward of their ingenuity and labour; the other, that the world may not be deprived of improvements, nor the progress of the arts be retarded. The act that secures copyright to authors guards against piracy of the words and sentiments; but it does not prohibit writing on the same subject." *Sayre* v. *Moore*, East 360n, 102 Eng. Rep. 139n (1785).

Opinion of the United States District Court of the Southern District of New York.

The author of a scientific article published in a professional journal is certainly not entitled to a monopoly of the ideas presented therein. In the "Abie's Irish Rose" case—*Nichols* v. *Universal Pictures Corporation,* 45 F. 2d 119, 121 (2d Cir., 1930)—Judge Learned Hand observed: "If Twelfth Night were copyrighted, it is quite possible that a second comer might so closely imitate Sir Toby Belch or Malvolio as to infringe, but it would not be enough that for one of his characters he cast a riotous knight who kept wassail to the discomfort of the household, or a vain and foppish steward who became amorous of his mistress. These would be no more than Shakespeare's 'ideas' in the play, as little capable of monopoly as Einstein's Doctrine of Relativity, or Darwin's theory of the Origin of Species."

Turning to the claim of unfair competition—inasmuch as there was no access and no appropriation of any substantial part of the material protected by the copyright in plaintiff's work, there can be no claim of unfair competition based on the content of defendants' work. Aside from the book itself, plaintiff urges unfair competition in the title and certain advertising matter. Titles of copyrighted works are not protected against their use by others unless they are distinctive and have acquired a secondary meaning. *Manners* v. *Triangle Film Corp.,* 247 Fed. 301, 303 (2d Cir. 1917); *Warner Bros. Pictures* v. *Majestic Pictures Corp.,* 70 F. 2d 310, 311 (2d Cir. 1934). The title "Oliver Wendell Holmes—Psychiatrist" has not acquired a secondary meaning and is wholly descriptive. *Kellogg Co.* v. *National Biscuit Co.,* 305 U. S. 111, 118 (1938). The title of defendants' book, "The Psychiatric Novels of Oliver Wendell Holmes" is also descriptive. It does not unfairly compete with that of plaintiff's article.

Plaintiff asserts that she has a right to the protection of her material independently of copyright on the theory of *International News Service* v. *Associated Press,* 248 U. S. 215 (1918),—a decision involving a news gathering service where protection was given against the raiding of

news services supplied by the plaintiff. This so-called "free ride" doctrine has been limited to cases where an attempt is made to secure an unfair advantage of the character proscribed in the Associated Press case. *Cheney Bros.* v. *Doris Silk Corp.*, 35 F. 2d 279, 281 (2d Cir. 1929), (cert. denied 281 U. S. 728); *Millinery Creators' Guild* v. *Federal Trade Commission*, 109 F. 2d 175, 177 (2d Cir. 1940); *R. C. A. Mfg. Co.* v. *Whiteman*, 114 F. 2d 86, 90 (2d Cir. 1940); *G. Ricordi & Co.* v. *Haendler*, 194 F. 2d 914, 916 (2d Cir. 1952).

Plaintiff's final claim is that certain quotations on the dust jacket of defendants' work invaded her legal rights because they assert that the Oberndorf book "Demonstrates Holmes' hitherto unsuspected knowledge of neuroses and the more clinical mental illnesses"; that he "has made a novel contribution to the literature of psychiatry. And for non-psychiatric readers he has opened a fascinating by-way in a familiar field"; that "in the light of Freudian psychiatry many of Holmes' aphorisms assume striking new meanings;" and that Oberndorf called attention "to the hitherto unnoticed psychological understanding of one of our famous doctors."

Plaintiff also objects to the following descriptions of the Oberndorf book by his publisher:

> "In the abridged novels long descriptions and details of plot are omitted in order to emphasize the medical and psychiatric aspects. Thus Elsie Venner is shown to be a brilliant study of a schizophrenic girl; A Mortal Antipathy, a portrait of a severe phobia; and the Guardian Angel, a study of multiple personality. Holmes himself is revealed as having a psychological originality and anticipated many of Freud's theories. * * *
>
> The book is a novel idea in psychiatric presentation and will appeal to everyone who is interested in the social aspect of mental disease."

These statements were a fair use of comments made by third parties concerning plaintiff's work; the comment by

Columbia is an accurate description. Neither in any way reflect upon or injure plaintiff.

In the last analysis, plaintiff rests her claims of copyright infringement and unfair competition on the premise that she anticipated Oberndorf in presenting the idea or theory that Holmes' so-called 'medicated novels'' anticipated the psychiatrists, and particularly the doctrine of dream states, submerged griefs and complexes developed by Freud. There is no property right in that idea and, in any event, plaintiff did not originate it. She ignores the fact that the subject was previously suggested by Van Wyck Brooks in his "Flowering of New England," a book which was on the best-seller lists for 1936-37. Oberndorf resorted to this work and actually quotes a statement from it concerning Holmes' "brilliant anticipation of Dr. Freud", and the observation that Holmes "had played into the hands of Dr. Freud."

While this decision rests upon the ground that there is no infringement of the copyright in plaintiff's work, and that the defendants did not indulge in unfair competition it should be noted that even if there had been any infringement, plaintiff would have no standing in this suit.

It is well settled that in an action for infringement of copyright, the copyright owner is an indispensable party. *Buck* v. *Elm Lodge, Inc.*, 83 F. 2d 201 (2d Cir. 1936); *Goldwyn Pictures Corp.* v. *Howells Sales Co.*, 282 Fed. 9 (2d Cir. 1922); *Kriger* v. *MacFadden Publications, Inc.*, 43 F. Supp. 170 (S. D. N. Y. 1941). Under certain circumstances the equitable owner of a copyright may be the proper party to bring a suit for infringement even though the legal title to the copyright is in the name of another. *Hoffman* v. *Santly-Joy, Inc.*, 51 F. Supp. 778, 779 (S. D. N. Y. 1943). Thus when the infringing party—the defendant—is the holder of the legal title to the copyright, the author of the work is entitled to maintain suit in his own name. *Bisel* v. *Ladner*, 1 F. 2d 436 (3d Cir. 1924); *Wooster* v. *Crane & Co.*, 147 Fed. 515, 516 (8th Cir. 1906), *supra*. But plaintiff must do more than plead the legal conclusion asserting equitable

ownership. Facts supporting the allegation that copyright was registered in the name of another for plaintiff's benefit must be established. *Hoffman* v. *Santly-Joy, Inc., supra; Southern Music Pub. Co.* v. *Walt Disney Productions,* 73 F. Supp. 580, 582 (S. D. N. Y. 1947).

Plaintiff has not offered any evidence to support her claim that she is the owner of the equitable title to the copyright. On the contrary, it appears that her article was accepted by the "Medical Journal" for "exclusive publication" in that magazine. Copyright was secured by the publisher in its name. There was no contract between the publisher and plaintiff, nor does plaintiff allude to any reservation of rights to her when she gave the publisher the authority to print her article in the "Medical Journal". In the absence of any proof to the contrary, it must be presumed that plaintiff transferred her work without any reservations whatever and that The Medical Journal & Record Publishing Company, Inc. became the absolute proprietor of the copyright. *Dam* v. *Kirk La Shelle Co.,* 175 Fed. 902 (2d Cir. 1910);[1] *Kriger* v. *MacFadden Publications, Inc., supra.* Plaintiff has, therefore, failed to establish her capacity to sue.

In a suit for copyright infringement, full costs are allowed to the prevailing party as a matter of right, and the court may award a reasonable attorney's fee to the prevailing party as part of the costs, 17 U. S. C. §116. *Marks* v. *Leo Feist, Inc.,* 8 F. 2d 460 (2d Cir. 1925). In this case, I find that an award of attorney's fees in the amount of $500 is reasonable.

The complaint is dismissed with costs and disbursements plus a counsel fee of $500.

Dated: June 28, 1955.

ALEXANDER BICKS,
United States District Judge.

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[1] Overruled on other grounds in *Sheldon* v. *Metro-Goldwyn Pictures Corporation,* 106 F. 2d 45, 50 (2nd Cir. 1939).

WILLIAM V. CONNELL, Clerk.

Judgment entered: 6-28-55.

Opinion *(Per Curiam)* of the United States Court of Appeals for the Second Circuit.

UNITED STATES COURT OF APPEALS

FOR THE SECOND CIRCUIT

No. 167—October Term, 1955.

(Argued December 15, 1955 Decided December 20, 1955.)

Docket No. 23789

ROSE ALEXANDER,

Plaintiff-Appellant,

v.

IRVING TRUST COMPANY, as Executor under the Last Will and Testament of CLARENCE P. OBERNDORF, Deceased, and COLUMBIA UNIVERSITY PRESS,

Defendants-Appellees.

Before:

CLARK, Chief Judge, and MEDINA and WATERMAN, Circuit Judges.

Appeal from the United States District Court for the Southern District of New York, Alexander Bicks, Judge.

Rose Alexander appeals from the dismissal of her action against the Irving Trust Company, as Executor under the Last Will and Testament of Clarence P. Oberndorf, and the Columbia University Press for copyright infringement and unfair competition based on the contention that Dr. Oberndorf's book, "The Psychiatric Novels of Oliver Wendell Holmes," published by the Press, infringes upon and unfairly competes with plaintiff's two-page article entitled,

"Oliver Wendell Holmes—Psychiatrist," published earlier in a now defunct medical journel. D. C. S. D. N. Y., 132 F. Supp. 364. Affirmed.

RICHARD J. MACKEY, New York City, for plaintiff-appellant.

DAVID ASCH, New York City (ABBERLEY, KOOIMAN & AMON, New York City), for defendant-appellee Irving Trust Company and SATTERLEE, WARFIELD & STEPHENS, New York City, for defendant-appellee Columbia University Press.

PER CURIAM:

Judge Bicks' reasoned and complete opinion, D. C. S. D. N. Y., 132 F. Supp. 364, demonstrates that there really is no basis for the plaintiff's claim of plagiarism and unfair competition. We are content to affirm upon that opinion.

The judgment below is affirmed, and the defendants are awarded the sum of $300 as counsel fees upon this appeal.

HAROLD B. WILLEY, C

Supreme Court of the United States

OCTOBER TERM, 1955.

No. 674.

ROSE ALEXANDER,

Petitioner,

vs.

IRVING TRUST COMPANY, as Executor under the Last Will and Testament of CLARENCE P. OBERNDORF, Deceased, and COLUMBIA UNIVERSITY PRESS,

Respondents.

BRIEF OF RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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vs.

IRVING TRUST COMPANY, as Executor under the Last Will and Testament of CLARENCE P. OBERNDORF, Deceased, and COLUMBIA UNIVERSITY PRESS,

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BRIEF OF RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

The issues dispositive of this case turn solely on questions of fact. Petitioner now seeks to have this Court assume the role of trier of those facts.

Petitioner claimed that respondents had copied her literary work, and had thereby violated her rights under the copyright laws and had tortiously caused damage to her.

All facts were found against petitioner. The District Court in an opinion (annexed to Petition, 18-26*), which was unanimously adopted by the Court of Appeals (*id.*, 27-8), found that there had been no access to plaintiff's work; that there were no similarities indicating copying;

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* Also to be found at pp. 3-11 of Appellant's Appendix and at 132 F. Supp. 364; affirmance reported, 228 F. 2d 221.

that the book of Dr. Oberndorf, the respondent author, was the result of independent labor without appropriation of any of plaintiff's matter; and further that the matters on the dust cover of the second edition of respondents' book (Appellant's Appx., 80-1, Ex. 10), "were a fair use of comments * * *" and "an accurate description," of the work and that "[n]either in any way reflect upon or injure plaintiff."

The only reason assigned in the present petition for granting a writ relates to the claim of tort based on the statements on the cover of the second edition of Dr. Oberndorf's book which petitioner continues to insist are false, despite the findings to the contrary.

The opinion of the District Court sets forth the facts fully; it is appropriate, however, to note the following:

Petitioner's sole contribution to literature or science was to set forth in her approximately 1600-word article, written to interest general practitioners to whom "psychiatry is very distasteful" (Appellant's Appx., 56, 65; R. 360, 388), the theory that Holmes' novels showed an understanding of psychiatry that was half a century ahead of his time, to which she

> "adds a few historical facts from both Holmes' life and the history of medicine. The references to the novels themselves are in general terms. The novels are neither summarized nor completely analyzed to establish the basis for plaintiff's conclusions" (Opinion, in Petition at p. 19).

Her work was unknown to Dr. Oberndorf when he published his book (*id.*, 21-2); nor was the theory new with her (*id.*, 25).

Dr. Oberndorf, on the other hand, in his 270-page volume, intended as a text book for medical students and the laity

(Appellant's Appx., 68-9; R. 407-8), "made a painstaking analysis of all three of Holmes' novels showing their practical application in terms of present-day psychiatric knowledge * * *. [It] was entirely original in its presentation of each of Holmes' three novels, abridged with a view to highlighting their significance as psychiatric and analytic studies of neuroses" (Opinion, see Petition, 19-20).

Plaintiff never sold anything written by her (Appellees' Appx., 2; R. 366). Her article, here involved, was contributed without compensation to a minor medical magazine (Appellant's Appx., 42; R. 319).

As any argument that facts should be found differently than they have been by the District Court and the Court of Appeals is without foundation, even were it material, it would not be proper to expand this brief in order to correct the inaccuracies in petitioner's statement of facts. The opinion of the District Court supplemented by the above short statement suffices to that end.

With the foregoing background, the futility of the sole "Reason for Granting Writ" assigned by petitioner becomes obvious.

Argument.

Petitioner indulges in a labored and fallacious argument based in part on her conception of *International News Service* v. *Associated Press,* 248 U. S. 215, and in part on the assumption that the pertinent facts in the present case are diametrically opposite to the findings of the lower courts (Petition, 10-17).

The net result of this is petitioner's conclusion that she should have injunctive relief because "a competitor in phychiatric practice and literature seized and used * * * the result of *her* labor and expense" [emphasis is peti-

tioner's] and caused others to be "deceived by his larceny" (*id.*, 16-17). This factual assertion is contrary to the findings of the District Court and the Court of Appeals, previously noted herein.

There is no inconsistency between the *International News* case and the present decision. The cited case turned upon the theory of *misappropriation* of a competitor's property or efforts. Here we have the finding that there was *no* appropriation.

The asserted erroneous interpretation by the Court of Appeals for the Second Circuit of the *International News* decision exists only in the mind of petitioner's counsel. Indeed, when Judge Learned Hand wrote the first of the opinions which counsel criticizes, *R. C. A. Mfg. Co.* v. *Whiteman*, 114 F. 2d 86 (Petition, 11) an attempt was made to secure a review by this Court, which denied the petition for certiorari then made (311 U. S. 712). In any event the asserted general error which petitioner assigns to the Court of Appeals in other cases does not affect the instant case, where the lower courts have found that there has been no appropriation by a competitor of the industry, skill or expense of another.

Finally, whether or not given conduct is tortious as petitioner asserts is solely a question of state law (*Fashions Originators' Guild* v. *Federal Trade Comm.*, 312 U. S. 457, 468). Except upon a definite showing of error as to the state law, this Court accepts the interpretation placed upon it by a local federal judge. (*Steele* v. *General Mills*, 329 U. S. 433, 439; *Helvering* v. *Stuart*, 317 U. S. 154, 163.) No such error is even adverted to in the present petition. Indeed, even were there no other reason therefor, the New York state law would have compelled dismissal of the instant complaint for failure to allege and prove special damages. (*Roger* v. *McCloskey*, 305 N. Y. 75; *Frawley Chem. Corp.* v.

A. P. Larson Co., 274 App. Div. 643; *Eversharp, Inc.* v. *Pal Blade Co.*, 182 Fed. 2d 779, 2d Circ.)

In short, there has not been advanced by petitioner a tenable reason of any sort, and, *a fortiori*, a special and important one, for review on writ of certiorari.

Conclusion.

The petition for a writ of certiorari should be denied.

Respectfully submitted,

DAVID ASCH,
Counsel for both respondents.